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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,622	08/18/2000	Ryukou Arisawa	32893	8248

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EXAMINER	
GEREZGIHER, YEMANE M	
ART UNIT	**PAPER NUMBER**
2144	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/642,622	ARISAWA ET AL.	
	Examiner	Art Unit	
	Yemane M Gerezgiher	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The reply mailed on 09/20/2004 has been entered. Claims 1-5 remain pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hsu** et al (U.S. Patent Number 6,587,684) hereinafter referred to as **Hsu** in view of **Takagaki** et al (Publication Number US 2002/0065066 A1) hereinafter referred to as **Takagaki** and further in view of **Kondou** et al (U.S. Patent Number 6,073,075) hereinafter referred to as **Kondou**.

Regarding claims 1-5, **Hsu** disclosed a digital wireless telephone system downloading software to a digital mobile station (cell phone) comprising a storage medium, where the system included a server having applications to be downloaded to the portable phone. **Hsu** disclosed mobile user sending request

messages to a destination server (claim 3) to establish a session between the digital telephone and the server for downloading new and update software applications related to the digital telephone service. See abstract and Fig 7 and 9. **Hsu** disclosed a "digital wireless telephone configured for recovering an executable program selected by the user and associated with digital telephone services from a stream of wireless data packets received from a digital wireless telephone network, and storing the executable program in a nonvolatile memory (claim 5) for execution by the digital wireless telephone where a digital wireless telephone is configured for sending selection inputs supplied by a user to a server via a digital wireless communications system, and receiving downloaded software from the server based on the selection inputs". See col.3, Lines 54-67. **Hsu** disclosed a portable phone downloading, storing application software in the storage medium of the portable phone and executing the multiple downloaded software which interact by exchanging network messages across API (application programming Interface). See col.4, Lines 17-54. **Hsu** showed a client browser executable by the portable telephone enabling the mobile phone user to navigate a network to select the downloading of different software applications as they are made available on the server that are executable by the digital

portable telephone (see col.4, lines 55-67) such as operating system, cell processing software and many more applications selected based on the mobile user's desired selections. See col.5, Lines 1-20. **Hsu** substantially disclosed the invention as claimed. However, **Hsu** did not explicitly teach the downloaded data been an audio data (music data) and application software expressly to play music data on portable telephone and recording a history of the downloaded data items.

An artisan working with **Hsu**'s invention related to downloading information data and a plurality of software application to a mobile station from a remote server would have been motivated to look for teachings that may have suggested downloading of different types of downloadable contents "in order to obtain information such as music, news and so on of desired contents at a desired time" (See Takagaki Page 1 paragraph [0006]). As evidenced by the teachings of **Takagaki** downloading and reproducing a music data in a portable device such as a cell-phone was known in the art at the time of the invention. **Takagaki** disclosed a mobile communication apparatus and information providing system where a client with a mobile device downloading a music data from a remote server having therein a plurality of music data stored. **Takagaki** taught downloading a music data into the storage means of the mobile

device, compressing the music data using different compression application techniques and reproducing high quality music on the mobile device. See ABSTRACT, Page 4, Section [0047] through Page 5. **Takagaki** substantially disclosed the claimed invention, but **Takagaki** was silent regarding recording a download history. However, as evidenced by the teachings of **Kondou** this feature was well known in the art at the time of the invention. **Kondou** taught recording a history of downloaded information. See Column 7, Line 60 through Column 8, Line 3.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of **Takagaki** related to downloading a music data from a remote server and reproducing a music data and have modified **Hsu** related to downloading data and software applications that are executable on the portable telephone in order to "obtain information such as music, news and so on of desired contents at a desired time" (See Takagaki Page 1 Section [0006]) and further facilitating a mobile phone to be used as a recording/reproducing apparatus of a high-fidelity (hi-fi) audio. See ABSTRACT, Page 1, Section [0010] and Page 4, Sections [0047] through [0052]. It is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to further take the teachings of

Kondou related to recording or logging history of download information and have modified the already combined teachings of **Takagaki** and **Hsu** related to music recording or reproducing on a mobile device, because such a modification would help eliminate the waste of downloading the same information that may have been already downloaded on the mobile station. See Column 7, Line 60 through Column 8, Line 3.

Response to Arguments

4. Applicant's arguments filed 09/20/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes

that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner points to the suggestion/motivation and the teachings disclosed by **Takagaki**. See ABSTRACT, Page 1, Sections [0006 and 0010] and Page 4, Sections [0047] through [0052].

As a general matter, not only the specific teachings of a reference but also reasonable inferences which an artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and In re Sherpard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a

particular reference. In re Bozek, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. In re Bode, 550 F.2d 656, 193 USPQ 545 (CCPA 1977). Lastly, In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), clearly states "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicants disclosure, reconstruction is proper".

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on Monday- Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (571) 272-3925.

Yemane M. Gerezgiher
Patent Examiner
Art Unit: 2144

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER
571 272 3932